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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,434	10/15/2003	Tetsuro Motoyama	242160US2CONT	7907
22850	7590	06/05/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PRICE, NATHAN E	
			ART UNIT	PAPER NUMBER
			2194	

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/684,434	Applicant(s) MOTOYAMA ET AL.	
	Examiner Nathan Price	Art Unit 2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,8,9,13,16,17,21,24,25,29 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,8,9,13,16,17,21,24,25,29 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/20/2006; 5/1/2006
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 20060526A
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 5, 8, 9, 13, 16, 17, 21, 24, 25, 29 and 32 are presented for examination. Claims 2-4, 6-7, 10-12, 14-15, 18-20, 22-23, 26-28 and 30-31 have been canceled.

Terminal Disclaimer

2. A terminal disclaimer was received 15 May 2006.

Response to Arguments

3. Applicant's arguments filed 5 January 2006, with respect to the argument that claim 1 not being comprised entirely of software, have been fully considered but they are not persuasive. See explanation below.

4. During an interview with Applicant's representative on 24 May 2006, an Examiner's amendment was approved to resolve the problem of the system claims being software. However, upon further review of the cited prior art, it was determined that the amendments to the independent claims made by Applicant are not sufficient to distinguish over the prior art. Since the Examiner's amendment will not place the application in condition for allowance, the Examiner's amendment approved by Applicant's representative is not being made by the Examiner at this time.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 5 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of independent claim 1 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Independent claim 1 does not appear to require any computer hardware to implement the claimed invention. This claim appears to define the metes and bounds of an invention comprised of software alone. There is no support (i.e., explicitly claimed computer hardware) in the body of the claims. The system of claim 1 appears to be a system comprised entirely of software. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. In *re Schrader*, 22 F.3d 290 at 294-95, 30 USPQ2d 1455 at 1458-59 (Fed. Cir. 1994). Transformation of data by a machine constitutes statutory subject matter if the claimed invention as a whole accomplishes a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d 1368, 1373, 47 USPQ2d 1596 at 1600-02 (Fed. Cir. 1998). MPEP 2106. *State*

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Street required transformation of data by a machine before it applied the “useful, concrete, and tangible test.” However, State Street does not hold that a “useful, concrete and tangible result” alone, without a machine, is sufficient for statutory subject matter. State Street, 149 F.3d at 1373, 47 USPQ2d at 1601.

Claims 1 and 5-8 are rejected under 35 U.S.C. 101 because the claimed invention appears to be comprised of software alone without claiming associated computer hardware required for execution. Applicant has argued that “an operation panel of an image forming device” is a “concrete element.” However, an operation panel could be a graphical user interface (GUI), and is therefore interpreted to include an operation panel created entirely in software. Also, a monitoring unit is not restricted to a hardware component, and can therefore be implemented entirely in software. Software alone, without the inclusion of hardware components so as to execute the software, cannot realize its functionality.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1, 5, 8/1, 8/5, 9, 13, 16/9, 16/13, 17, 21, 24/17, 24/21 25, 29, 32/25 and 32/29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wygodny et al (U S Pat. 6,202,199) in view of Hintermeister et al (U S Pat. 6,345,306), Motoyama (U S Pat. 5,568,618) and official notice that a graphical user interface (GUI) used to control devices is well known in the art.

As to claim 9, Wygodny teaches a system comprising:

interface means (OCX/Active-X controls to be traced) of a target application means (client), the interface means for providing a plurality of operations to be selected by a user [inherent to the operations of OCX/Active-X controls] (col. 28, lines 28-38);

monitoring means for monitoring (trace library) data of selecting of the plurality of operations of the interface means by the user, and for generating a log (trace log file) of the monitored data (col. 6, lines 3-11),

communicating means for communicating the log of the monitored data (remote mode, send trace log file by e-mail, col. 6, lines 49-54).

Wygodny teaches a setting unit (trace control information CTI file) configured to set a number of sessions of the target application to be executed by the user prior to the communicating unit communicating the log of the monitored data (col. 10, line 51 – col. 11, line 30). Trace duration (number of sessions) is a typical trace control parameter, and therefore, it would have been obvious to include such information into the CTI file Wygodny.

While Wygodny teaches communicating data to a remote site (remote mode, cols. 5-6), which typically requires marshalling/packaging the data,

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Wygodny does not teach packaging the log of the monitored data into different forms of the monitored data using a packaging object derived from an abstract class, and receiving an object derived from the abstract class including the log of the monitored data. Wygodny also does not teach that the interface is an operation panel of an image forming device.

Hintermeister teaches data communication, including packaging the data (package elements) into different forms using a packaging object (packager 126) derived from an abstract class (Package base class of the framework), and receiving an object derived from the abstract class (derived classes such as Physical Contents) including the data (package elements, col. 6, lines 5-31).

Therefore, it would have been obvious to include packaging the log of the monitored data into different forms of the monitored data using a packaging object derived from an abstract class, and receiving an object derived from the abstract class including the log of the monitored data. One of ordinary skill in the art would have been motivated to combine the teachings of Wygodny and Hintermeister because this would have allowed easy and efficient definition of different output formats (col. 2, lines 5-37).

Hintermeister also teaches an abstract class (Framework mechanism 124, col. 9 lines 4 – 5) including first and second derived classes, the first derived class storing data of one session (col. 9 lines 34 – 36) and the second derived class storing data of the set number of sessions (col. 9 lines 14 – 27).

As to the interface being an operation panel, official notice is taken that it is well known in the art that a graphical user interface (GUI) can be implemented to

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allow a user to control a physical device, including devices such as printers and scanners. Therefore, the operation panel can be implemented in software, and monitoring of software is taught by the references. As stated in the previous Office Action, Wygodny teaches the target application is a software application (client 102) and the interface is a display screen of the software application (OCX/Active-X controls to be traced) [It is noted that OCX/Active-X controls are used to implement typical GUI elements of window applications].

In addition to the use of graphical user interfaces used to control devices being well known in the art, Motoyama teaches a target application is an image forming device and the interface is an operation panel of the image forming device, and a target application is an appliance and the interface is an operation panel of the appliance (remote diagnostics on business office devices, col. 1, lines 16-33, col. 6, lines 8-38).

Therefore, it would have been obvious to include image forming device, appliance and operation panel into Wygodny as modified. One of ordinary skill in the art would have been motivated to combine the teachings of Wygodny as modified and Motoyama because this would have provided controls of various models and products (col. 1, lines 53-62).

As to claim 1, note discussion of claim 9.

As to claims 17 and 25, they are a method claim and a program product claim of claim 9 and thus note discussion of claim 9.

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As to claims 5, 13, 21 and 29, Wygodny teaches sending the log of the monitored data when the user exits the target application (log and send trace log file when client terminates, col. 6, lines 1-20).

As to claims 8/1, 8/5, 16/9, 16/13, 24/17, 24/21, 32/25 and 32/29, Wygodny teaches the communicating unit communicates the log of the monitored data by Internet mail (send trace log file by e-mail, col. 6, lines 49-54).

9. The issues raised by the Applicant that remain relevant to the current rejections of the claims and are addressed below.

As stated in the above rejections, the operation panel can be implemented in software as a GUI, which provides a user controls to use when operating a device. When controls on an operation panel are used, it instructs the software to perform certain operations (for example: start, stop, transfer data). Therefore, user inputs to the software result in providing Wygodny with data to trace, which includes "execution paths, subroutine calls, and variable usage" (see Applicant's REMARKS, page 10 ¶ 2), that can be controlled using an operation panel implemented in software as a GUI. This includes monitoring selections of operations on an operation panel implemented as a GUI.

With respect to Applicant's argument that Motoyama is unrelated to the teachings of Wygodny, Motoyama discloses that business devices, such as high-speed copiers, include microprocessors and software (col. 1 lines 28 – 48). In addition, Motoyama discloses that microprocessors are used for "various tasks, including an operation panel consisting of many buttons and displays, controlled

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by a microprocessor" (col. 1 lines 31 – 33). Therefore, devices disclosed in Motoyama include software and an operation panel to control their operation, which, as described above, can include an operation panel implemented in software that can be monitored. When a user provides input to the operation panel, the input can affect the execution paths, subroutine calls, and variable usage, all of which can be monitored, thereby monitoring the user's input and usage of the device through the operation panel. Therefore, one of ordinary skill in the art at the time of Applicant's invention would have been motivated to combine a disclosure for monitoring software execution with a disclosure that describes a device that operates using software.

Conclusion

1. The prior art made of record on the P.T.O. 892 that has not been relied upon is considered pertinent to applicant's disclosure. Careful consideration of the cited art is required prior to responding to this Office Action, see 37 C.F.R. 1.111(c).
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Price whose telephone number is (571) 272-4196. The examiner can normally be reached on 7:30am - 4:00pm, Monday - Friday.

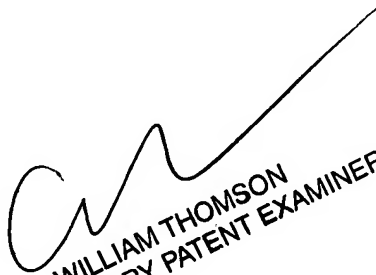
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Thomson can be reached on (571) 272-3718.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NP


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